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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of:

HAEBERLI

Application No.: 09/560,222

Filed: 4/28/2000

For: **SYSTEM AND METHOD OF
CHANGING ATTRIBUTES OF AN
IMAGE-BASED PRODUCT**

Examiner: **Fadok, Mark A.**

Art Unit: **3668**

**AMENDED APPEAL BRIEF IN
RESPONSE TO NOTICE OF NON-
COMPLIANCE NOTICE**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Amended Brief is submitted in response to the Notice of Non-Compliance mailed July 8, 2005. The Notice of Appeal was filed on March 8, 2005 in response to the final rejection of Claims 112-135 of the above-identified application, as set forth in the Final Office Action mailed December 22, 2004. As this Amended Brief is responsive to the Notice of Non-Compliant Notice, no fee is required. Authorization is granted to charge any other required small entity fee for filing this Brief to Deposit Account 501861.

I. REAL PARTY OF INTEREST

The Real Party of Interest is Shutterfly Inc., a Delaware corporation.

II. RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences for the above-referenced patent application.

III. STATUS OF CLAIMS

Claims 112-135 are pending and are the subject of this Appeal.

IV. STATUS OF AMENDMENTS

A Final Office Action mailed December 22, 2004 maintained its rejection of claims 112-135 under Section 103(a) as unpatentable over Garfinkle(USPN 6,017,157) in view of Official Notice. Claim 112 was previously amended. A Notice of Appeal was filed on March 8, 2005.

V. SUMMARY OF THE INVENTION

Briefly, as stated on page 49 (Abstract), Appellant's invention relates to a system and method for changing attributes of an image-based product in which an attribute of a first image is automatically identified and a new value for a product attribute of the image-based product is automatically selected based on the image attribute. Also, a user interface can be provided that allows a user to actuate a user interface control in order to select a new value for a product attribute of an image-based product. Such techniques can be used to offer image-based products for sale over a computer network such as the Internet so that the user can change attributes of the image-based products before ordering.

Turning now to the first element of claim 1, the "automatically identifying an attribute" is discussed for one implementation on page 15, lines 2-9 of the instant Specification as: "[a] set of attributes for the image-based product (also referred to here as "product attributes") is received (block 302). In the case of an image print, the product attributes can include, for example, the size of the image print, the number and identity of the images included in the image print, cropping information, and the size, style, and

color of any border surrounding the image portion of the image print. The set of attributes can be received from the user, for example, by having the user enter or select attributes using a browser executing on the client computer 104. Also, the set of attributes can be retrieved from storage, for example, from a database, or otherwise provided."

In the implementation, the automatically selecting a new value is discussed as follows:

As shown in FIG. 20, changing one or more attributes of an image-based product involves selecting which product attributes to change (block 2002) and then selecting a new value for the selected attributes (block 2004). Both of these operations can be performed manually by a user (e.g., where the user actuates one or more controls in order to select which product attributes to change and/or to select a new value for the selected attributes) or automatically by the system 100 (e.g., where the system 100 is commanded by the user or otherwise to select which product attributes to change and/or to select a new value for the selected attributes). For example, the system 100 can automatically select the one or more product attributes to change at random. In addition, or instead, the system 100 can automatically select one or more of the product attributes to change based on information relating to the user's images, past transactions, and account information. For example, the system 100 can select one or more product attributes that the user's account information indicates the user has not tried changing (perhaps, because the user was unaware that the particular attribute could be changed). Also, the system 100 can select new values for the selected product attributes at random and/or based on information relating to the user's images, past transactions, and account information. In this way, the system 100 suggests new ways to incorporate a user's image in an image-based product. The automatic selection of which product attributes to change and the automatic selection of a new value for the selected attributes can be performed by any component of the system 100 (e.g., by the server 102 and/or the client computer 104). Specification at page 15, line 25- page 16, line 13.

As discussed on page 8, line 8 of the specification, "advantages that can be seen in implementations of the invention include one or more of the following. Generating and displaying a preview image of an image-based product allows a user to see how the image-based product will look with a particular set of product attributes. In this way, the user can determine if the user wishes to order such an image-based product and/or modify one or more of the attributes of that image-based product. For example, a preview image of an image print can be generated from an image selected by the user. The user can

change one or more attributes of the image print, for example, the minimum border width, border style, border color, and print size.”

VI. ISSUES PRESENTED FOR REVIEW

1. WHETHER CLAIMS 112-135 ARE UNPATENTABLE UNDER 35 U.S.C. 103(A) OVER GARFINKLE IN VIEW OF OFFICIAL NOTICE.

VII. GROUPING OF CLAIMS

For each ground of rejection that appellant contest herein, which applies to more than one claim, such additional claims, to the extent separately identified and argued below, do not stand or fall together.

VIII. ARGUMENT

1. WHETHER CLAIMS 112-135 ARE UNPATENTABLE UNDER 35 U.S.C. 103(A) OVER GARFINKLE IN VIEW OF OFFICIAL NOTICE.

In regards to claim 112, the August 4, 2004 Office Action noted that:

Garfinkle discloses receiving a first image from a receiving a request for a demonstration of an image-based product by the user (FIG 5B);

Garfinkle teaches processing digital photos along with delivering and storing digital image products on a server for a customer to upload and download images to a client computer for modification of attributes of the digital image from a client computer (col 7, lines 4-42) and plurality of products (thumbnails, gifts, col 7, lines 53-60), but does not specifically mention that the attributes are automatically selected and presented to the user. It would have been obvious to a person having ordinary skill in the art to include in Garfinkle, automatically demonstrating a product with modifications available, since it has been held that broadly providing a mechanical or automatic means to replace manual activity, which has accomplished the same result, involves only routine skill in the art. *In re Verner*, 120 USPQ 192. Garfinkle would have been motivated to incorporate the demonstration of a product, because this is a notoriously well known method for showing a product for sale that is modified from its original presentation; for example, showing the tee shirt or mug of Garfinkle with the image shown on it provides for an excellent way for people to visualize the product and thus increase the likelihood of a sale.

Applicant may argue that the manipulation of the product attributes occurs not on the server, but at the client computer. However, it would have been

obvious to one having ordinary skill in the art at the time the invention was made to (describe modification), since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

In the Final Office Action, the examiner maintained that "the instant application merely automates a common function of cropping, bordering, changing a photograph into a oil like painting or a water color picture, ect, see (Yokomizo (col 3, line 65, for an example or these and other functions or the demonstration of options and styles as is shown in Fredlund (col 6, lines 7-15)."

Applicants respectfully traverse this assertion. Yokomizo relates to a manual system (as opposed to an automated system that selects product features without any human intervention. The section cited by the examiner noted that the "shop personnel or the user himself can effect various editorial work on the image data by using an editing table provided in the shop, in order to obtain any desired edited picture. For instance, a desktop computer may be used as the editing desk. Editorial functions available in this embodiment include, for example, changing into a photograph of a tone like an oil painting or a watercolor picture, selectable by clicking corresponding buttons. Other kinds of processing are also available, such as sharpening of a defocus photographic picture, red-eye processing for removing the red-eye effect (change into black eye picture), and so forth. Any and all types of editorial functions can be implemented in this embodiment."

In contrast, claim 112 relates to a method for automatically demonstrating a product feature associated with a plurality of image-based products, each image-based product having one or more product attributes and the claims recite

- receiving a first image from a user;
- receiving a request for a demonstration of an image-based product by the user;
- automatically selecting one of the plurality of image-based products by a computer;
- automatically selecting at least one of the product attributes for the selected image-based product; and
- automatically processing a first preview image of the selected image-based product having the selected product attributes using the image provided by the user.

Garfinkle and Yokomizo require operations to be done manually by a user (e.g., where the user actuates one or more controls in order to select which product attributes to change and/or to select a new value for the selected attributes).

In contrast, the claimed invention does not require user intervention, but is about automatically demonstrating a product feature associated with a plurality of image-based products by automatically selecting one of the plurality of image-based products by a computer; automatically selecting at least one of the product attributes for the selected image-based product having the selected product attributes using the image provided by the user. The claimed invention operates without any user selection or user intervention in selecting the product attributes.

As shown in Table I in the following page, Garfinkle is completely silent on having computers automatically make selections of image-based products and product attributes:

Table I. Comparisons of Garfinkle, the instant Application and Office Action Assertion

Disclosure relied on by Office Action	Claim	Office Action Assertion
<p>Garfinkle User provides images User makes decisions on selecting products to be produced from the images, and User makes decisions on selecting properties for the products</p> <p>Yokomizo shop personnel or the user himself can effect various editorial work on the image data by using an editing table provided in the shop, in order to obtain any desired edited picture</p>	<p>A method for automatically demonstrating a product feature associated with a plurality of image-based products, each image-based product having one or more product attributes. The computer automatically selects one of the plurality of image-based products by a computer; and automatically selecting at least one of the product attributes for the selected image-based product.</p> <p>The invention thus allows a computer to select and render a quickly preview what a final product COULD look like without user specifying the details of the preview. The user can still manually makes his/her own decisions on image product or product attributes.</p>	<p>It is obvious that computer can automatically make decisions for the user to select products and product attributes.</p>

One embodiment of the invention is described as follows:

As noted above, the system 100 can automatically select which product attributes to change and select new values for the selected product attributes. In one implementation shown in FIGS. 16 and 17A-17B, a user can cause the system 100 to automatically select which product attributes to change and the new values for the selected product attributes by actuating a user interface control such as a button. FIG. 16 is a flow diagram of process of causing a system 100 to automatically select which product attributes to change and the new values for the selected product attributes. First, a user interface control is displayed (block 1602). The user interface control can be any user interface element by which a user can initiate a command. Examples include a button, menu, menu item,

command line, key sequence, selection box, and icon. Specification at Page 28, lines 5-14.

Here, Garfinkle does not show each and every element of the claim, namely Garfinkle fails to show at least automatically selecting one of the plurality of image-based products by a computer; automatically selecting at least one of the product attributes for the selected image-based product; and automatically processing a first preview image of the selected image-based product having the selected product attributes using the image provided by the user.

Even with the Official Notice, there is no showing the specifics of a method for automatically demonstrating a product feature associated with a plurality of image-based products, each image-based product having one or more product attributes, comprising receiving a first image from a user; receiving a request for a demonstration of an image-based product by the user; automatically selecting one of the plurality of image-based products by a computer; automatically selecting at least one of the product attributes for the selected image-based product; and automatically processing a first preview image of the selected image-based product having the selected product attributes using the image provided by the user. Hence, the references singly or in combination cannot render independent claim and those dependent therefrom obvious.

Per MPEP 706.02(j): Contents of a 35 U.S.C. 103 Rejection

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. In re Vaack, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP Section 2143 - Section 2143.03 for decisions pertinent to each of these criteria.

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the

claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). See MPEP Section 2144 - Section 2144.09 for examples of reasoning supporting obviousness rejections.

Applicants submit that there is no suggestion to modify Garfinkle to arrive at the invention as claimed. There is no reasonable expectation of success. Moreover, the reference does not teach or suggest all the claim limitations in the independent claims as well as each dependent claims. Since the teaching or suggestion to make the claimed combination and the reasonable expectation of success is not found in Garfinkle, there is an inference that it came from Applicants' disclosure.

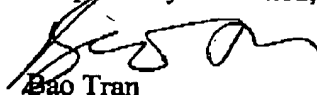
In sum, since none of the references show the claimed elements recited in the claims, Applicant submits that they cannot render obvious independent claim 112. The dependent claims are allowable since they depend from allowable independent claims. The rejection should be withdrawn and the claims be allowed.

CONCLUSION

Applicants believe that the above discussion is fully responsive to all grounds of rejection set for the in the Office Action.

If for any reasons the Examiner believes a telephone conference would in any way expedite resolution of the issues raised in this appeal, the Examiner is invited to telephone the undersigned at 408-528-7490.

Respectfully submitted,



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APPENDIX - PENDING CLAIMS

1-111. Cancelled.

112. (Previously Amended) A method for automatically demonstrating a product feature associated with a plurality of image-based products, each image-based product having one or more product attributes, comprising:

receiving a first image from a user;

receiving a request for a demonstration of an image-based product by the user;

automatically selecting one of the plurality of image-based products by a computer;

automatically selecting at least one of the product attributes for the selected image-based product; and

automatically processing a first preview image of the selected image-based product having the selected product attributes using the image provided by the user.

113. (No change) The method of claim 112, further comprising:
displaying the first preview image of the image-based product.

114. (No change) The method of claim 113, wherein displaying the first preview image of the image-based product includes:
downloading the first preview image to a client computer; and
displaying the first preview image on the client computer.

115. (No change) The method of claim 112, further comprising uploading the first image from a client computer to a server using a computer network.

116. (No change) The method of claim 112, further comprising receiving a selection of the first image from a plurality of images.

117. (No change) The method of claim 112, wherein the attribute of the first image includes a color attribute of the first image.

118. (No change) The method of claim 112, wherein the attribute of the first image includes an image border attribute of the first image.

119. (No change) The method of claim 112, wherein automatically identifying the image attribute includes analyzing the first image.

120. (No change) The method of claim 119, wherein the new value for the product attribute is automatically selected based on the analysis of the first image.

121. (No change) The method of claim 119, wherein analyzing the first image includes generating a set of representative colors from the first image.

122. (No change) The method of claim 120, wherein automatically selecting the new value for the product attribute includes selecting a color as a function of at least one of the representative colors.

123. (No change) The method of claim 122, wherein selecting the color as a function of at least one of the representative colors includes selecting a color that matches at least one of the representative colors.

124. (No change) The method of claim 123, wherein selecting the color that matches at least one of the representative colors includes selecting a color that complements at least one of the representative colors.

125. (No change) The method of claim 122, wherein selecting the color as a function of at least one of the representative colors includes selecting the color from the set of representative colors.

126. (No change) The method of claim 125, wherein selecting the color from the set of representative colors includes selecting the most popular color.
127. (No change) The method of claim 125, wherein selecting the color from the set of representative colors includes selecting the color at random from the set of representative colors.
128. (No change) The method of claim 112, wherein the product attribute is a border color product attribute of the image-based product and the new value is the selected color.
129. (No change) The method of claim 128, further comprising generating a second preview image of the image-based product having a border, wherein the color of the border is the color specified by the border color product attribute.
130. (No change) The method of claim 112, wherein selecting a new value for the product attribute includes selecting the new value at random.
131. (No change) The method of claim 130, wherein the selection of the new value is constrained based on previous values of the product attribute.
132. (No change) The method of claim 112, wherein selecting a new value for the product attribute includes selecting the new value at pseudo-random.
133. (No change) The method of claim 112, wherein selecting a new value for the product attribute includes selecting the new value from a predetermined ordering of values.
134. (No change) The method of claim 112, wherein the product attribute relates to which images are incorporated in the image-based product, and the image-based product further incorporates at least a portion of a second image.

135. (No change) The method of claim 112, further comprising:
receiving a plurality of images;
automatically identifying an image attribute of each of the received images; and
automatically selecting the first and second images from the received images based on
the image attributes of the received images.

136. (No change) The method of claim 112, further comprising fulfilling the order
for the image-based product.